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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,030	09/03/2003	Yung-Chun Lei	MTKP0014USA	2029
27765	7590	09/09/2005		EXAMINER
NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116				ELMORE, STEPHEN C
			ART UNIT	PAPER NUMBER
			2186	

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/605,030	LEI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stephen Elmore	2186	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 September 2003.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 03 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**STEPHEN C. ELMORE**  
 PRIMARY EXAMINER

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 3/11/2004.

- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

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**DETAILED ACTION**

1. This Office action responds to the application filed September 3, 2003.
2. Claims 1-18 are presented for examination.

*Drawings*

3. The drawings are objected to because:

a. The drawings are objected to under 37 CFR § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following feature(s) must be shown or the feature(s) canceled from the claim(s):

- 1) claim 9, the feature "wherein during the update...no data access...is allowed";
- 2) claim 18, the feature "forbidding any data access...during the update";

No new matter should be entered.

b. The drawings are objected to under 37 CFR § 1.84(o) because the following drawing elements lack meaningful legends (i.e., a numerical reference character is not a meaningful legend):

- 1) Figure 4, elements 95 and 96.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR § 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

4. Claim 11 is objected to because of the following informalities: "datatransmission" is a typo.

**Appropriate correction is required.**

***Specification***

5. The disclosure is objected to because of the following:

a. the Summary is objected to because it states two contradictory concepts, first, that the bus controller directly updates the firmware in the non-volatile memory (NVM), second, that the control interface updates data stored in the NVM, these are contradictory because both elements cannot be the primary agent for updating the NVM, so this language needs to be corrected to improve the understanding of what activities each element actually are responsible for;

b. the Specification is objected to, because it contains non-idiomatic English language, the instances too numerous to specifically point out, the specification uses and repeats the same language as is used in the claims which language has been rejected under 35 USC 112, second paragraph for indefiniteness based on non-idiomatic English usage, correct the specification for the same non-idiomatic English language as already rejected in the claims;

c. the Specification contains typos.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

**Appropriate correction is required.**

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because:

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- a. Claim 1 -- "prior piece of data" and "current piece of data", these are not clear, are non-idiomatic English, prior to what? and current with respect to what?;
- b. Claim 1 -- "for comparison" is not clear, there is missing essential subject matter, a comparison must be made between two or more things, but the claim omits what elements the comparison is being performed with and omits the nature of the comparison activity, more information is required to define the scope of the activity "comparison" because the missing information is essential to the act of comparing;
- c. Claims 3 and 12 -- "capable of" does not positively recite whether or not the loading takes place;
- d. Claims 6 and 15 -- "prior piece of data" is non-idiomatic English, is not clear, prior to what?;
- e. Claims 8 and 17 -- "address register for setting addresses", is non-idiomatic English, address registers are not active agents they are passive, they cannot perform "setting" of addresses, something else in the invention must be performing the setting activity;
- f. Claim 8 and 17 -- "an address...is increased", is non-idiomatic English, addresses can be incremented, or decremented by some amount, and other operations can be performed on addresses, but "increasing" addresses is unclear in scope of meaning of the activity being performed;
- g. Claims 8 and 17 -- "an NVM page register for setting a download capacity", is non-idiomatic English, registers do not set capacities, they are passive elements, they only store data, further, "download capacity" is unclear as to what element the "capacity" is a capacity of;
- h. Claims 8 and 17 -- "the address set by the NVM address register", is non-idiomatic English, addresses are stored in registers, a passive activity, registers cannot perform "setting" activities;
- i. Claims 8 and 17 -- "command registers for executing commands", is non-idiomatic English, registers cannot perform "executing" activities;
- j. Claim 9 -- "no data access...is allowed" is not clear, there is missing essential subject matter, the claim omits what element in the invention prohibits the data access, and omits by what

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activity or how the data access is not allowed, more information is required to define the scope of the activity "no data access...is allowed" because the missing information is essential to the act of not allowing;

k. Claim 10 -- provides for the use of "the NVM control interface to update" and use of "the NVM control interface to read", but, since the claim does not set forth any steps involved in either of the method/processes of using, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

l. Claim 10 -- "prior piece of data" and "current piece of data" is non-idiomatic English, these are not clear, prior to what? and current with respect to what?;

m. Claim 10 -- "for comparison" is not clear, there is missing essential subject matter, a comparison must be made between two or more things, but the claim omits what other elements the comparison is being performed with, and omits the specific nature of the comparison activity, more information is required to define the scope of the activity "comparison" because the missing information is essential to the act of comparing;

n. Claim 18 -- "forbidding any data access...during update" is non-idiomatic English, is not clear, there is missing essential subject matter, the claim omits what element in the invention forbids the data access, and omits what the forbidding activity consists of, more information is required to define the scope of the activity "forbidding any data access...during update" because the missing information is essential to the act of forbidding;

o. Dependent Claims not already specifically rejected inherit the deficiencies of the preceding claim in the claim dependency chain.

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*In re Steele*

8. Claims 1-18 are therefore withdrawn from further consideration (e.g., such as under 35 USC §§ 102 or 103) because it is improper for the examiner to rely on speculative assumptions regarding the meaning of a claim or claims and then to base a rejection on these assumptions under 35 USC § 103. *In re Steele*, 305 F.2d 859,134 USPQ 292 (CCPA 1962).

The state of the disclosure and claims are such that it is not possible for the examiner to determine with any degree of specificity or distinctness the scope of coverage of these claims and limitations, to the extent that the examiner is uncertain as to what invention is presently being claimed in claims 1-18.

Additionally, where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. In the present application there exists great uncertainty as to the proper interpretation of the limitations of these claims and even upon reading the specification, drawings, and claims taken as a whole, such reading does not permit one of ordinary skill in the art to comprehend the scope of coverage for these claims desired by the applicant due to the numerous problems in interpreting the meaning of the claims as noted above in the objections and rejections of the disclosure and claims.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Elmore whose telephone number is (571) 272-4436. The examiner can normally be reached on Mon-Fri from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim can be reached on (571) 272-4182. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 5, 2005



**STEPHEN C. ELMORE  
PRIMARY EXAMINER**